

Docket Number 09/779,156
Docket 00/053 MFE
Art Unit 1774
Page: 7

REMARKS

Claims 1 through 11 and 16 through 20 are pending in the application.

Applicants acknowledge with gratitude the Examiner's indication that Claim 16 will be allowed upon amending into independent form. Claim 16 has been so amended, and Applicants respectfully submit that Claim 16 is now in condition for allowance.

Applicants further acknowledge with gratitude the Examiner's indication that Claim 7 is patentable in light of the art of record. Applicants thus anticipate that Claim 7 will be allowed upon entry of the enclosed terminal disclaimer.

Claim 1 has been amended to emphasize that the crystallizable thermoplastic consists entirely of polyester. Support for this amendment can be found in the application as filed.

Claim 8 has been amended to delete the phrase "said film further formed in the absence of heat stabilizers."

Claims 17 and 18 have been amended to depend from allowed Claim 16. Claims 17 and 18 have further been amended to delete the phrase "said film further formed in the absence of heat stabilizers."

Claim 20 has been amended to delete the phrase "said film further formed in the absence of heat stabilizers."

Applicants respectfully submit that this response does not raise new issues, but merely places the above-referenced application either in condition for allowance, or alternatively, in better form for appeal. Reexamination and reconsideration of this

Docket Number 09/779,156

Docket 00/053 MFE

Art Unit 1774

Page: 8

application, withdrawal of all rejections, and formal notification of the allowability of the pending claims are earnestly solicited in light of the remarks which follow.

Double Patenting Rejection

Claims 1 through 9 stand rejected under the judicially created doctrine of obviousness-type double patenting in light of United States Patent No. 6,521,351 to Murschall et al. Solely to advance prosecution of the case and without addressing the merits of the rejection, Applicants submit herewith a terminal disclaimer, as noted in Applicants Amendment of October 27, 2003. More particularly, Applicants submit herewith a terminal disclaimer disclaiming the terminal part of any patents granted on the above-identified application extending beyond the expiration date of the full statutory term which may ultimately result from United States Patent No. 6,521,351.

Rejection Under 35 USC § 112

Claims 8, 17, 18 and 20 stand rejected under 35 USC 112, first paragraph, based on the phrase "in the absence of heat stabilizers." Applicants respectfully note that films omitting thermal stabilizers are supported by the working examples on Page 14, line 10 through Page 15, line 27.

However, solely to advance prosecution, Claims 8, 17, 18 and 20 have been amended to delete the phrase "in the absence of heat stabilizers." Accordingly, Applicants respectfully request withdrawal of this rejection.

Claim 19 stands rejected over the phrase "lower than the luminous transmittance of a comparable film formed from said crystallizable thermoplastic having the same thickness as said film and lower longitudinal orientation than said film." Applicants respectfully submit that the Application as filed notes on Page 11, starting at line 25 that "[a] relative increase of 7% in the longitudinal stretching ratio gave a relative reduction

Docket Number 09/779,156
Docket 00/053 MFE
Art Unit 1774
Page: 9

of from 15 to 20% in transparency." As reflected in the Application as filed on Page 12, line 27 through Page 13, line 2, "luminous transparency" and "transparency" are both defined as the ratio of the total light transmitted to the amount of incident light. Consequently, these terms may be used interchangeably.

Applicants thus respectfully submit that the specification conveys with reasonable clarity to those skilled in the art that Applicants were in possession of the claimed aspects reflected in Claim 19. Accordingly, Applicants respectfully request withdrawal of this rejection, as well.

Rejection Under 35 USC § 103

Claims 1 through 5 and 9 through 11 stand rejected under 35 USC 103(a) as unpatentable over United States Patent No. 4,933,043 to Kim. Applicants respectfully note there has been a typographical error within the outstanding action, and that the Kim patent referenced within the Office Action of November 27, 2002, is United States Patent No. 5,660,931. The patent number cited within the Office Action, United States Patent No. 4,933,043, is to Instance.

Claim 6 stands rejected as unpatentable over Kim in view of United States Patent No. 4,384,040 to von Meer.

It may be useful to consider the invention as recited in the claims before addressing the merits of the rejection. The claims recite opaque, white films with a thickness of from 10 to 500 μm . The recited films are formed from a crystallizable thermoplastic which consists entirely of polyester, along with barium sulfate and at least one optical brightener. The film further includes a functional coating having a thickness of from 5 to 10 nm. Surprising, the luminous transmittance of the claimed films film is reduced when the longitudinal stretch ratio is increased for a film of the same thickness.

Docket Number 09/779,156
Docket 00/053 MFE
Art Unit 1774
Page: 10

Applicants have determined a beneficial combination of a particular pigment, i.e. barium sulfate, optical brightener, and functional coatings that provide a highly beneficial balance of properties. More specifically, the opaque, white films of the invention provide good mechanical properties and good optical properties, as well as a range of functionalities, such as sealability, printability, and the like.

Applicants continue to respectfully submit that Kim does not teach or suggest the claimed invention. Kim is directed to polyester films that contain polyolefin. (Col. 1, lines 60 – 65). In fact, Kim incorporates up to 40 % polyolefin. (Col. 2, lines 61 – 64). Kim includes the polyolefin to form voids within the polyester. (Col. 4, lines 9 – 14). Polyolefins are known to have a detrimental impact in polyester compositions, as repeatedly expressly noted by Kim. In particular, Kim notes the inclusion of heat stabilizers to counteract the degradation and discoloration imparted by the polyolefin during extrusion and heat aging. (Col. 6, lines 29 – 49; see also Col. 1, lines 46 – 50 noted below).

Kim, considered either alone or in combination with the art of record, does not teach or suggest the claimed invention, reciting a crystallizable thermoplastic consisting entirely of polyester.

In contrast to the opinion urged in the Office Action, Applicants respectfully submit that the inclusion of even such minimal amounts of polyolefin as 1 weight percent would be expected to materially alter the claimed films. The Office Action specifically indicates that 1 weight percent polyolefin would not affect the opacity of Kim's films. Applicants respectfully submit that the presence of even minimal amounts of polyolefin would materially change the basic and novel characteristics of the claimed films, regardless of its particular effect on opacity. The Examiner's attention is kindly directed to MPEP 211.03 (quoting In re Herz). The Examiner will kindly note Kim's own repeated references to the incompatibility of polyolefins within polyester compositions. For example, Kim notes that "in case a polyolefin resin is blended with a polyester, due

Docket Number 09/779,156

Docket 00/053 MFE

Art Unit 1774

Page: 11

to the poor heat resistance of the polyolefin, the mechanical properties of the resulting polymer film are apt to deteriorate." (Col. 1, lines 46 – 50).

However, out of an abundance of caution, the claims have been amended to recite that the crystallizable thermoplastic used to form the films of the invention consists entirely of polyester.

The Office Action further urges that the open transition phrase within Claim 1, allows the inclusion of further additives. Although the claim as a whole does, in fact, recite an open transition phrase, the claim as amended is now fully closed with respect to suitable crystallizable thermoplastic resins. Stated differently, the films of the invention may incorporate only polyester as the crystallizable thermoplastic resin. Hence polyolefins, which are also crystallizable thermoplastic resins, would clearly be excluded.

Accordingly, Kim does not teach or suggest films formed from crystallizable thermoplastic that consists entirely of polyester. In fact, by requiring the inclusion of polyolefin, Kim teaches away from the claimed films.

Applicants also respectfully reiterate that Kim does not teach or suggest the recited reduction in luminous transmittance. Such a reduction was altogether unexpected. The Office Action notes that the claimed reduction in luminous transmittance is not supported within the specification. As noted above, Applicants respectfully submit that the claimed reduction is fully supported on Page 11, line 20 through Page 12, line 1.

Kim further does not teach or suggest films in which at least one surface of the film bears a functional coating with a thickness of from 5 to 10 nm.

Accordingly, Applicants respectfully submit that the claimed invention is patentable in light of Kim, considered either alone or in combination with the art of record.

Docket Number 09/779,136
Docket 00/053 MFE
Art Unit 1774
Page: 12

Applicants respectfully reiterate that Von Meer does not cure the deficiencies within Kim in regards to Claim 6. Von Meer is directed to paper substrates coated with a waterproof coating. The waterproofed paper substrates are subsequently coated with a photographic emulsion. (Col. 2, lines 24 - 27). The waterproof coating is formed from unsaturated polymerizable resins, such as vinyl monomers. (Col. 2, lines 38 - 41). Blue dye may be included within the waterproof coating, in an unspecified amount. (Col. 4, lines 19 - 21).

Van Meer, directed to paper substrates having a dyed coating, does not indicate the conventionality of blue dye within the recited polyester films. The composition, processing conditions and resulting properties of the claimed polyester films are altogether different from the unsaturated polymerizable coating resins of Van Meer.

Applicants respectfully reiterate that merely because the references can be combined is not enough, there must still be a suggestion. MPEP 2143.01 (section citing Mills). Kim is directed to films used in packaging. Van Meer is directed to photographic paper. These are altogether different fields of endeavor.

However, even if the cited references were combined (which Applicants submit should not be done), the claimed invention would not result. Kim expressly requires the presence of polyolefin. Von Meer merely discloses dyed coatings on a paper substrate. Consequently, none of the art of record, considered either alone or in combination, teaches or suggests the recited films formed from crystallizable thermoplastic consisting entirely of polyester, much less polyester films incorporating a polyester-soluble blue dye, and most certainly not such films incorporating blue dye in an amount ranging from 10 to 10,000 ppm.

Accordingly, Applicants respectfully submit that Claim 6 is patentable in light of Kim and von Meer, considered either alone or in combination.

Docket Number 09/779,156
Docket 00/053 MFE
Art Unit 1774
Page: 13

Based on the foregoing, Applicants respectfully submit that Claims 1 through 11 and 17 through 20 are patentable in light of the art of record, considered either alone or in combination.

CONCLUSION

It is respectfully submitted that Applicants have made a significant and important contribution to the art, which is neither disclosed nor suggested in the art. It is believed that all of pending Claims 1 through 11 and Claims 16 through 20 are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned if any questions remain to expedite examination of this application.

It is not believed that fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional fees are necessary to allow consideration of this paper, the fees are hereby authorized to be charged to Deposit Account No. 50-2193.

Respectfully submitted,



Klaus Schweitzer
See attached Limited Recognition
Under 37 CFR§10.9(b)

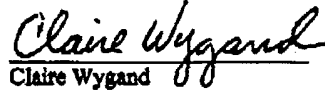
ProPat, L.L.C.
425-C South Sharon Amity Road
Charlotte, NC 28211-2841
Telephone: 704-365-4881
Facsimile: 704-365-4851

PROPA, LLC
FAX: 1063834037
APR 19 2004 11:13 P.20

Docket Number 09/779,156
Docket 00/053 MFE
Art Unit 1774
Page: 14

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to facsimile number (703) 872-9306 at the United States Patent and Trademark Office on April 19, 2004.


Claire Wygand